

REMARKS

This paper is in response to the official action dated June 27, 2003 (hereafter, the "official action").

Claims 1-30 are pending in the application. By the foregoing amendments, claims 1, 3, 8, 10, 14, 16, and 21-26 have been amended. Claims 1-30 are at issue.

Support for the amendments to the claims may be found variously throughout the application and in the claims as originally filed. No new matter has been added.

Claims 1, 3-5, 7, 8, 10, 11, 14, 16-18, 21-26, and 28-30 have been rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 2,956,038 to Juelss *et al.* ("the '038 patent"). Claims 1, 3-8, 10-14, and 16-23 have been rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 2,833,736 to Glaser ("the '736 patent").

Additionally, claims 2, 9, 15, and 27 have been objected to, but are allowable in substance.

The various bases for the claim rejections are addressed below in the order presented in the official action. Reconsideration of the application, in view of the foregoing amendments and the following remarks, is solicited.

Claim Rejections - 35 U.S.C. §102(b)

The applicants respectfully traverse the rejections of claims 1, 3-5, 7, 8, 10, 11, 14, 16-18, 21-26, and 28-30 as anticipated under 35 U.S.C. §102(b) by the '038 patent.

It is well-established that each and every limitation of a claimed invention must be present in a single prior art reference in order for anticipation to occur. *See*, for example, *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998). The standard for anticipation is one of strict identity. This standard has not been satisfied with respect to the pending claims, as amended herein.

Each of the pending claims 1-30 has been amended to recite a pigment selected from the group consisting of pearlescent pigments, mica flake pigments, glass flake pigments, and metal flake pigments. The examiner has recognized that "[t]he references alone or in combination fail to teach an erasable ink composition

wherein the pigment was [a] pearlescent pigments, mica flake pigments, glass flake pigments and metal flake pigments. Therefore the references are not seen to teach or fairly suggest the claimed invention." *See* official action at page 3. Accordingly, the applicants respectfully submit that the rejection of claims 1, 3-5, 7, 8, 10, 11, 14, 16-18, 21-26, and 28-30 as anticipated by the '038 patent under 35 U.S.C. §102(b) should be withdrawn, in view of the amendments made herein.

The applicants respectfully traverse the rejections of claims 1, 3-8, 10-14, and 16-23 as anticipated under 35 U.S.C. §102(b) by the '736 patent.

For the reasons discussed above, the applicants also respectfully submit that the rejection of claims 1, 3-8, 10-14, and 16-23 as anticipated by the '736 patent under 35 U.S.C. §102(b) should be withdrawn.

Conclusion

It is respectfully submitted that the application is now in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, she is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

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Andrew M. Lawrence

Andrew M. Lawrence, Reg. No. 46,130
Attorney for Applicants
6300 Sears Tower
233 S. Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300